

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 1648

Examiner: Bao Q. Li

In re application of:
Daniel T. Mytych *et al.*

Serial No.: 09/643,458

Filing Date: August 22, 2000

Attorney Docket No.: JB0976Q US

Title:
METHODS AND REAGENTS
FOR THE DETECTION OF
ANTIBODIES TO ADENOVIRUSAPPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b)Kenilworth, NJ 07033
November 22, 2004Mail Stop: Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Application is a request for reconsideration of the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that was issued in the above-identified application. Applicants submit herewith form PTO/SB/17, which authorizes the USPTO to charge the appropriate fee under 37 C.F.R. § 1.18(e) to applicants' deposit account.

11/23/2004 SDIRETA2 00000005 190365 09643458

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REMARKS

Claims 1-3, 8 and 23-25 are pending and have been allowed.

Statement of Facts regarding the patent term adjustment, as required by 37 C.F.R. § 1.705 (b)(2),
is as follows:

The Determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which was issued in conjunction with a Notice of Allowance, indicated that the patent term adjustment for the above-identified application is 24 days. Applicants disagree with the USPTO's calculation of the patent term adjustment.

Applicants believe they are entitled to a patent term adjustment of 476 days.

Applicants believe that they are entitled to a patent term credit under 37 C.F.R. § 1.702(a)(1). The above-identified application was filed on August 22, 2000, yet a notification under 35 U.S.C. § 132, in this case a Restriction Requirement, was not mailed until October 1, 2003. This time frame exceeds the allowed fourteen months. Therefore, applicants believe that, according to 37 C.F.R. § 1.703(a)(1), they are entitled to a patent term adjustment credit of 709 days.

Applicants also believe that they are subject to a patent term debit under 37 C.F.R. § 1.704(b). A first Office Action was mailed on March 23, 2004. Applicants mailed a response to the first Office Action on July 23, 2004. The Office received the response on July 28, 2004. This time frame exceeds the allowed three months. Therefore, applicants believe that, according to 37 C.F.R. § 1.704(b), they are subject to a patent term adjustment debit of 35 days.

In addition, applicants believe that they are subject to a patent term debit under 37 C.F.R. § 1.704(c)(7). A Notice to File Missing Parts was mailed on June 26, 2001. Applicants mailed a response to the Notice to File Missing Parts on July 5, 2001. The Office received the response to the Notice to File Missing Parts on July 9, 2001. A Notice of Incomplete Reply was mailed on December 6, 2001. Applicants mailed a response to the Notice of Incomplete Reply on December 17, 2001. The Office received the response to the Notice of Incomplete Reply on January 23, 2002. Applicants believe that, according to 37 C.F.R. § 1.704(c)(7), they are subject to a patent term adjustment beginning on the day after the date the reply having an omission was filed, which is July 10, 2001, and ending on the date that the reply

correcting the omission was filed, which is January 23, 2002. Therefore, applicants believe that, according to 37 C.F.R. § 1.704(c)(7), they are subject to a patent term adjustment debit of 198 days.

Applicants note that the Office mailed a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures on February 22, 2002. Applicants mailed a response to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures on April 22, 2002 along with a Preliminary Amendment, which was received by the Office on April 29, 2002. This time frame does not exceed the allowed three months. Therefore, applicants believe that, according to 37 C.F.R. § 1.704(b), they are not subject to a patent term adjustment for this time period.

Finally, applicants believe that the Notice of Abandonment Under 37 C.F.R. § 1.53 (f) or (g) mailed by the Office on September 9, 2002, which was directed to the Notice to File Missing Parts mailed on February 22, 2002, was sent in error because a response to the Notice to File Missing Parts was timely filed, within the two month period, on April 22, 2002. Accordingly, applicants believe that they should not be penalized for the Notice of Abandonment.

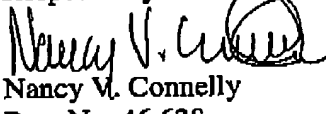
No time was consumed by continued examination, an interference proceeding, imposition of a secrecy order, review by the Board of Patent Appeals and Interferences or delay in processing of the application requested by the applicants for the above-identified application [37 C.F.R. §1.702(b)].

In light of the above and the fact that this patent application is not subject to a terminal disclaimer, applicants believe that the correct patent term adjustment should be a credit of 476 days ($709 - 35 - 198 = 476$).

CONCLUSION

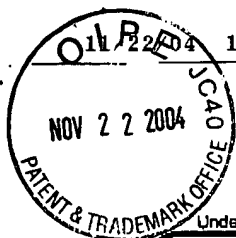
Applicants submit that the USPTO's calculation of the patent term adjustment for the above-identified application is incorrect. Applicants believe they are entitled to a credit of 476 days, rather than 24 days. Accordingly, reconsideration of the calculation of the patent term adjustment is earnestly solicited.

Respectfully submitted,


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PTO/SB/17 (10-04)

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FEE TRANSMITTAL for FY 2005

Effective 1010112004. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$1 200.00)

Complete if Known

Application Number	09/643,458
Filing Date	08/22/2000
First Named Inventor	Daniel T. Mytych et al.
Examiner Name	Li, Bao Q.
Art Unit	1648
Attorney Docket No.	JB0976Q

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit
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Deposit
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Name

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Schering-Plough Corporation

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1001 790	2001 395	Utility filing fee	
1002 350	2002 175	Design filing fee	
1003 550	2003 275	Plant filing fee	
1004 790	2004 395	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims below	Fee from	Fee Paid
Independent	-20" =	X	
Multiple Dependent	-3- =	X	

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 88	2201 44	Independent claims in excess of 3
1203 300	2203 150	Multiple dependent claim, if not paid
1204 88	2204 44	Reissue Independent claims over original patent
1205 18	2205 9	Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

* or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

FEE Code (\$)	FEE Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 430	2252 215	Extension for reply within second month	
1253 980	2253 490	Extension for reply within third month	
1254 1,530	2254 765	Extension for reply within fourth month	
1255 2,080	2255 1,040	Extension for reply within fifth month	
1401 340	2401 170	Notice of Appeal	
1402 340	2402 170	Filing a brief in support of an appeal	
1403 300	2403 150	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,370	2501 685	Utility issue fee (or reissue)	
1502 490	2502 245	Design issue fee	
1503 660	2503 330	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 790	2809 395	Filing a submission after final rejection (37 CFR 1.128(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR 1.128(b))	
1801 790	2801 395	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) Patent Term Adjustment - Application

200.00

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$1 200.00)

SUBMITTED BY

Name (Print/Type) Nancy V. Connelly

Registration No. 46,638

Telephone 908-298-4107

Signature

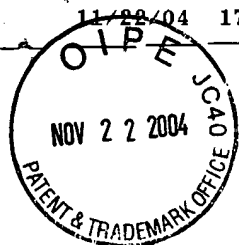
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FROM:

Nancy V. Connelly

PHONE NUMBER:

(908) 298-5098

TOTAL NO. OF PAGES INCLUDING COVER

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November 22, 2004

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Application No. 09/643,458

In Re Application of Mytych *et al.*

Filed: 08/22/2000

Group Art Unit: 1648

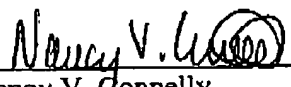
For: METHODS AND REAGENTS FOR THE DETECTION OF
ANTIBODIES TO ADENOVIRUS

Attorney Docket No.: JB09760

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Transmitted herewith are:

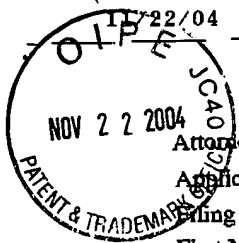
- Application for Patent Term Adjustment Under 37 CFR 1.705(b) - 4 pages
- Fee Transmittal form - 1 page IN DUPLICATE
- Fax Certification of Transmission - 1 page
- Fax Cover Sheet - 1 page


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Attorney Docket No.: JB0976Q

Application No.: 09/643,458

Filing Date: 08/22/2000

First Named Inventor: Daniel T. Mytych et al.

PTO/SB/97 (08-03)

Approved for use through 07/31/2006. OMB 0851-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

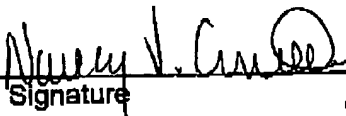
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